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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.                    |
|---|-------------|----------------------|---------------------|-------------------------------------|
| 09/997,160  | 11/29/2001  | Sumio Kuroda         | 1100.66020          | 3617                                |
| 7590  | 11/04/2003  |                      |                     | EXAMINER<br>HECKENBERG JR, DONALD H |
| Patrick G. Burns<br>GREER, BURNS & CRAIN, LTD.<br>300 South Wacker Dr., Suite 2500<br>Chicago, IL 60606 |             |                      | ART UNIT<br>1722    | PAPER NUMBER                        |

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|------------------------------|------------------------|---------------------|--|
|                              | 09/997,160             | KURODA, SUMIO       |  |
| <b>Examiner</b>              | <b>Art Unit</b>        |                     |  |
| Donald Heckenberg            | 1722                   |                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 02 September 2003 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 17-19 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 29 November 2001 is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_.  
4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

1. Applicant's election without traverse of Group IV (claims 17-19) in response to previous Office Action is acknowledged.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashimoto et al. (U.S. Pat. No. 6,332,338).

Hashimoto discloses a substrate of a recording medium and a process of making the substrate using a graphite mold (see cl. 3, ll. 26-35 and cl. 5, ll. 20-39).

Claims 17-19 all recite "A substrate of a recording medium which is manufactured..." As noted in the previous Office Action (the restriction requirement), these claims have been interpreted as being product by process claims. There is no such thing as a "product by apparatus" claim type, thus based on the

"manufactured by" language in the claims, the only reasonable interpretation is that these claims are product-by-process claims.

The determination of patentability in product by process claims is based on the product itself. The patentability does not depend on the method of production. In re Thorpe, 777 F.2d 965, 967, 227 USPQ 964, 966 (Fed. Cir. 1985); In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); MPEP § 2113. As claims 17-19 recite only a substrate of a recording medium with no other features, Hashimoto anticipates these claims as described above.

4. Claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinoshita et al. (U.S. Pat. No. 5,948,496).

Kinoshita discloses a substrate for a recording medium which includes an information pattern including servo information (cl. 4, ll. 20-28).

As noted above in the rejection under 35 U.S.C. 102(e) with Hashimoto, claims 17-19 are interpreted as product by process claims. As Kinoshita discloses of the features of the claimed product, the reference anticipates claims 17-19.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 972-9306. The unofficial fax phone number is (703) 305-3602.

  
Donald Heckenberg  
October 23, 2003

  
JAMES P. MACKEY  
PRIMARY EXAMINER

10/27/03